

**considered by selecting the K' acceptance band or allowed to be considered by selecting the K acceptance band.**

The method taught in Best concerns the use of a validation range K or a validation range K' that corresponds to the same article. In particular, Best illustrates his technique by showing that the measuring signals of most genuine 1 German DM coins are between the reference values  $r_u$  and  $R_o$  of curve E shown in Fig. 1. This range is designated channel K. Curve F in Fig. 1 corresponds to a Polish 20 Zloty coin which is worth a fraction of a German 1 DM coin, and part of curve F overlaps that of curve E. If the coin validator operates with acceptance band K for 1 DM coins, then there is a greater chance that some 20 Zloty coins will also be erroneously accepted. If a narrower acceptance band K' for 1 DM coins is used, then the probability that some 20 Zloty coins will be accepted is reduced (See Best, col. 3, line 56 to col. 4, line 20). Therefore, both the K acceptance band and the K' acceptance band correspond to the same article type, namely 1 DM coins. Neither of these bands corresponds to the Zloty coin (or to the measured signal distribution of curve F).

In contrast, claim 14 recites a currency validation method wherein the measured properties are checked against a plurality of sets of criteria, each set corresponding to a predetermined type of article. The technique automatically prevents a single one of the sets from being considered during a validation period of a subsequent validation operation. It is submitted that changing the coin set against which the articles' measured properties are checked, as recited in claim 14, is not the same as narrowing or

widening a coin acceptance window for a particular coin type as taught by Best. Thus, the applicant respectfully reasserts that claim 14 is not anticipated by Best.

Similarly, claim 15 concerns automatically adding a set of criteria associated with a different type of article for consideration during a subsequent validation period. Such operation is neither taught or suggested by Best and thus claim 15 is not anticipated.

The apparatus of claim 16 functions to prevent a set of criteria from being operable by preventing one of the sets of criteria from being effective during a subsequent validation operation, and then preventing incrementing of a credit count for that type of article. The device of claim 17 functions to enable a set of criteria to be operable by enabling one of the sets of criteria to be effective during a subsequent validation operation, and then enabling incrementing of a credit count when the predetermined type of article is recognized. Such devices operating in such manners are not taught or suggested by Best, and thus claims 16 and 17 are not anticipated.

In view of the above remarks, the applicant respectfully requests withdrawal of the 35 U.S.C. §102(b) rejections of claims 14-17.

**3. Claims 1, 9 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Griner, cited herewith. Fig. 4 of Griner shows that coins that are rejected as nickels and quarters are then tested as dimes, see col. 6, lines 6-43. Therefore, the measured properties of dimes are checked against two sets of criteria, each set corresponding to a predetermined type of article, the dimes are rejected and then subsequently the measured properties are checked against the criteria for dimes.**

The applicant respectfully disagrees with the interpretation set forth in paragraph 3 of the Action concerning Fig. 4 of Griner. The flowchart of Fig. 4 clearly describes a technique for

validating coins that first checks to see if calculated ratios are within the ratios in a reference memory 258 corresponding to nickels 410. If not, then a check for quarters 420 is made. If not, then a check for dimes 432 is made. Lastly, if not, the coin is rejected 428. It is respectfully asserted that Griner does not teach to reject a genuine dime in step 410 or in step 420, but rather teaches to check the measured properties against those for nickels and quarters first before accepting the dime in steps 432 and 434. In contrast, pending claim 1 recites to first make a determination to either reject or accept a coin, and then to subsequently determine whether the measured properties meet at least one further set of criteria of an article of a different type. Griner neither teaches or suggests to conduct any subsequent checking of criteria after accepting an article or rejecting it. Consequently, claim 1 is not anticipated, and dependent claims 9 and 11 are not anticipated for at least the same reasons. Thus, withdrawal of the 35 U.S.C. §102(b) rejections of claims 1, 9 and 11 is requested.

#### Claim Rejections - 35 USC §103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2-5, 7, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griner in view of Best. Griner shows all the features of the applicants' claimed invention except altering the sets of criteria prior to issuing a valid signal. Best discloses in col. 5, lines 42-55 altering the sets of criteria prior to issuing a valid signal. Best discloses in col. 5, lines 42-55 altering the sets of criteria prior to issuing a valid signal to switch to a wide band for one criteria if the coin has already met a narrow band of another criteria or vice versa so that the coin does not have to meet the narrow band of each criteria and therefore fewer good coins will be erroneously rejected. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Best to modify the device of Griner to include means to alter the criteria prior to acceptance of coins by switching between narrow and wide bands to limit the number of good coins erroneously rejected.

Claims 2-5, 7 and 10 depend either directly or indirectly on claim 1. As explained above, Griner does not teach or suggest to first make a determination as to the validity or invalidity of an article, and then to subsequently determine whether the measured properties meet at least one further set of criteria of an article of a different type as recited in claim 1. In addition, Best does not teach or suggest to subsequently determine (after a coin has been validated or rejected) whether the measured properties meet at least one further set of criteria of an article of a different type. Consequently, since neither Griner or Best, along or in combination, teaches or suggests the technique recited in claim 1, then claim 1 is patentably distinct thereover and dependent claims 2-5, 7 and 10 should be allowable for at least the same reasons.

Claim 12 recites a method for validating articles of currency that includes determining, as a result of the checking operation, whether the article is one of said types, wherein the criteria relating to respective types of articles are considered in a sequence, and the sequence is altered for a subsequent validation operation. Although Griner teaches a sequence of checking criteria for nickels, quarters and then dimes against a ratio corresponding to measured properties of an article, Griner does not teach or suggest to

alter the sequence for a subsequent validation operation. Best also does not teach or suggest to alter a sequence. Consequently, Griner or Best, alone or in combination, fails to teach or suggest to altering the sequence in which criteria relating to respective types of articles are considered as recited in claim 12. Claim 12 is thus patentably distinct thereover, and dependent claim 13 should be allowable for at least the same reasons.

In view of the above remarks, the applicant respectfully requests withdrawal of the 35 U.S.C. §103 rejections of claims 2-5, 7, 10, 12 and 13.

#### **Allowable Subject Matter**

6. Claims 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The applicant respectfully declines to rewrite claims 6 and 8 as suggested in view of the above remarks.

#### **Response to Arguments**

7. The applicants' remarks have been considered but have not been found persuasive in view of the art as now applied to claims 1-5, 7 and 9-13. With respect to claims 14 and 15 the applicants argue that the removal or addition of a set of criteria could be for any article, counterfeit or not. Claims 14 and 15 call broadly for a single one of the sets of criteria to be added or removed. Therefore, the removal or addition of any one of the criteria, even the criteria of the counterfeit coins, meets the limitations of these claims. The applicants argue that claims 16 and 17 allow for changing the sets of denominations that are to be accepted. It is noted that the limitation: "denominations", does not appear in these claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).